

or an additive employment of one or more prior art system concepts to provide a particular solution or to bring about a desired result."

The Applicant responds by pointing out that the Examiner does not cite the patent statute, the patent regulations, the MPEP, or any case law. The above quoted paragraph is merely conclusory, it provides no evidence whatsoever to back up the assertions contained therein.

MPEP 2106 states: "It is essential that patent applicants obtain a prompt yet complete examination of their applications...each claim should be reviewed for compliance with every statutory requirement for patentability in the initial review of the application....Office personnel should state all reasons and bases for rejecting claims in the first office action. Deficiencies should be explained clearly..." The Applicants assert that the Examiner has not complied with this directive and has not met the above stated burden.

The Applicant respectfully requests that the Examiner's Office Action be withdrawn and a prompt Notice of Allowance issued forthwith.

## **2. § 112 Rejections**

The Examiner has rejected claims 1 – 83 under 35 U.S.C. §112. The Applicant respectfully asserts that the Examiner has failed to make a prima facie case under any of the paragraphs of 35 U.S.C. § 112.

### **A. Statutory Basis for the Examiner's Rejection**

On page 2 of the Office Action, the Examiner presents the following paragraph as, apparently, a restatement of 35 U.S.C. §112:

"35 USC 112 rejections:

- a. The disclosure like the claims must point out the invention. A disclosure in which the lexicography is unclear. Vague convoluted or incomplete does not comply with the statute.
- b. A disclosure which merely discusses prior art concepts without really setting forth on independently arrived at enabling disclosure does not comply.
- c. Claims based on a disclosure as above are vague, incomplete or merely expressions or desired results do not comply with the statute."

According to MPEP 706.03(c),(d), the Statutory Basis for both 35 U.S.C. §112, first paragraph, and 35 U.S.C. §112, second paragraph is required in a first action on the merits. The Patent Office provides the Examining Corp with a form paragraphs for this very purpose

(See, for example, Form Paragraph 7.30.01). On the other hand, the Examiner's aforementioned paragraph does not provide proper statutory basis for his rejection. In fact, the above paragraph does not appear to be taken from any portion of the patent statute, the patent regulations, the MPEP, or from any case law that the applicant is aware of. According to MPEP 706, "the standards of patentability applied in the examination of claims must be the same throughout the Office."

To compound matters, the Examiner does not provide any evidence to back up any of his assertions. "A description as filed is presumed to be adequate, unless or until sufficient evidence or reasoning to the contrary has been presented by the examiner to rebut the presumption." *In re Marzocchi*, 169 USPQ 367, 370 (CCPA 1971), MPEP 2163, III. A. Not once in his Office Action does the Examiner point to a particular claim or a particular portion of the specification or drawings. The Examiner has not met his burden of proof.

The Examiner implies that the disclosure of the present invention is not enabling. However, "the examiner has the initial burden to establish a reasonable basis to question the enablement provided for the claimed invention." *In re Wright*, 27 USPQ2d 1510, 1513 (Fed. Cir. 1993). According to MPEP 2164.04, the examiner must construe the claims before any enablement analysis can occur. "It is incumbent upon the patent office, whenever a rejection on this basis is made, to explain why it doubts the truth or accuracy of any statement in a supporting disclosure and to back up assertions of its own with acceptable evidence or reasoning which is inconsistent with the contested statement..." *In re Marzocchi*, 169 USPQ at 370 (CCPA 1971). The Examiner has not met this burden because he provides no analysis indicating why the disclosure is not enabling. The examiner presents no analysis of the claims, and no analysis of the specification. In fact, the examiner does not cite or analyze a single claim, or a single portion of the specification. The Examiner provides no evidence or reasoning in support of his assertions.

#### **B. Statement of Rejection:**

On page 4 of the Office Action, the Examiner rejects all of the claims filed in the case with the following statement:

"Claims 1-83 are rejected under 35 USC 112. Multiple sets of claims obscures rather than points out the invention. Read each claim term by term on the drawing and show unity of invention or make election."

The Applicant respectfully points out that the Examiner's rejection is not in accordance with §112 of the patent statute. To the contrary, the Applicant has a right to file as many claims as he desires, so long as the claims are not redundant.

In his rejection under §112, the Examiner instructs the Applicant to "read each claim term by term on the drawing and show unity of invention or make election." This is improper. First of all, the term "unity of invention" is not mentioned in §112. The term "unity of invention" is typically used in European practice. Second, it is not the Applicant's burden to show "unity of invention," it is the Examiner's burden to shown that there is more than one invention being claimed. If the Examiner desires to restrict the claims, he must do so under 35 U.S.C. §121, and follow the procedure outlined in Chapter 800 of the MPEP. According to MPEP 803, the Examiner must provide reasons and examples to make a prima facie argument for a restriction or an election of species. The Examiner has not done so.

For the aforementioned reasons, the Applicant respectfully requests that the rejection of claims 1-83 under 35 U.S.C. §112 be withdrawn.

### **3. § 102/103 Rejection**

The Examiner has rejected claims 1-83 under 35 U.S.C. § 102/103 over U.S. Patent No. 5,929,418 to Ehrhart et al. (hereinafter Ehrhart). The Examiner states that Ehrhart "teaches the essential system in view of the concomitant prior art which teaches that color coding is Garden variety." The Applicant respectfully traverses the rejection because the Examiner has failed to make a prima facie case of anticipation and/or a prima facie case of obviousness.

The Examiner's rejection is confusing in several ways. The Applicant is not completely sure what the Examiner is asserting when he rejects the claims under "35 U.S.C. § 102/103." Claims may be rejected under 35 U.S.C. §102 as being anticipated by a reference or, in the alternative, under 35 U.S.C. §103 as obvious over the reference. However, the rejection does not say this. Second, the Examiner does not explain what he means by the term "essential system." Any prior art rejection must include an analysis of the claims. The claims are the legal definition of the "system." Finally, the Examiner does not identify "the concomitant prior art." If the Examiner is applying art in addition to Ehrhart, he has an obligation to cite it.

**A. Rejection under 35 U.S.C. § 102/103 is improper**

According to MPEP 706.02(m), a rejection under §102, or in the alternative, under §103, cannot be used as a substitute for a rejection under 35 U.S.C. § 102. There are only a handful of reasons where this rejection is appropriate. First, this type of rejection may be used when the interpretation of the claims is in dispute. This does not apply here because the Examiner has not provided any interpretation of the claims. The Examiner's Office Action does not attempt to analyze a single claim element. See MPEP 2111-2116.01 for claim interpretation guidelines.

Second, this type of rejection may be used when there is a question of claim limitations being inherent in a reference. See *In re Fitzgerald*, 205 USPQ 594 (CCPA 1980). However, this does not apply because the Office Action does not discuss inherency.

Third, this type of rejection may be employed when the reference teaches a small genus which places a claimed species in the possession of the public. See *In re Schaumann*, 197 USPQ 5 (CCPA 1978). The Examiner provides no analysis or arguments indicating that this scenario applies to the instant application.

Fourth, this type of rejection is applicable when the reference teaches a product that is the same as the product set forth in a product-by-process claim. *In re Marosi*, 218 USPQ 289 (Fed. Cir. 1983). This is not applicable because the claims being examined do not employ product-by-process claims.

Fifth, this type of rejection may be used to reject means-plus-function claims under certain circumstances. See MPEP 2183 – 2184. This is not applicable to the claims set forth in the instant application because they do not employ means plus function limitations.

Finally, this type of rejection may be used when the ranges disclosed in a reference and the claimed ranges overlap, but the reference does not contain a specific example within the range. *Ex Parte Lee*, 31 USPQ2d 1105 (Bd. Pat. App. & Inter. 1993). The Examiner has not provided any reasons why this scenario is applicable either.

For the reasons provided above, the Applicant respectfully asserts that the rejection under 35 U.S.C. § 102/103 is improper and should be withdrawn. The Examiner should apply the reference to the claims and either reject the claims under §102 or §103, or allow the claims and issue a notice of allowance.

### **B. Patentability Standard for Anticipation**

According to MPEP 2131, "to anticipate a claim, the reference must teach every element of the claim." A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference. *Verdegaal Bros. v. Union Oil of California*, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). The identical invention must be shown in as complete detail as is contained in the claims. *Richardson v. Suzuki Motor Co.*, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989).

The Examiner has failed to make a *prima facie* case of anticipation. The Examiner states that Ehrhart "teaches the essential system in view of the concomitant prior art which teaches that color coding is Garden variety." The problem with the Examiner's rejection is that he provides no analysis of either the claimed invention or the cited reference. The Applicant is at a loss in trying to understand what the Examiner is referring to when he mentions the "concomitant prior art." The Applicant is also at a loss in trying to understand what the Examiner means when he states that "color coding is garden variety." Claim 1, for example, says nothing whatsoever about color coding.

The Examiner is required to point out where in the reference each claim limitation can be found. The Examiner has failed to meet his burden, and thus, no *prima facie* case of anticipation has been established.

### **C. Patentability Standard for Obviousness**

According to the MPEP 2143, three basic criteria must be met to establish a *prima facie* case of obviousness. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

The Examiner has failed to make a *prima facie* case of obviousness because he did not satisfy the above stated burden. Again, in rejecting the claims, the Examiner states that Ehrhart "teaches the essential system in view of the concomitant prior art which teaches that color coding is Garden variety." Applicants gently point out that this is not the standard by

which claims are to be examined under 35 U.S.C. §103. Referring to the standard enunciated in *In re Vaeck*, the Examiner has failed to point out where in the cited reference all of the claim limitations can be found. The Examiner makes no attempt to provide a cogent analysis of the claims, the specification, or the cited reference. The Examiner does not apply a single reference teaching to a single claim element.

Second, the Examiner has failed to provide any suggestion or motivation to modify the reference teachings. Because the Examiner does not apply a single reference teaching to any single claim element, he also does not discuss any reference modifications.

In *Ex Parte Rozzi*, the Board of Patent Appeals and Interferences vacated the Examiner's rejection on grounds of anticipation and obviousness because the examiner had made "no cogent attempt to read the reference onto the independent claim in the application," and therefore had not "established that he determined that all limitations of the applicant's claims are explicitly or inherently described by the prior art." *Ex Parte Rozzi*, 63 USPQ2d 1196 (Bd. Pat. App. & Inter. 2002). The above cited analysis of the Board applies equally well to the Examiner's First Office Action on the merits, because the Examiner has failed to make any cogent attempt to read the reference onto any of the claims in the application.

For the aforementioned reasons, the Applicant respectfully requests that the rejection of claims 1-83 under 35 U.S.C. § 102 for anticipation or, in the alternative, under 35 U.S.C. § 103 for obviousness be withdrawn.

#### 4. Conclusion

Based upon the above remarks and papers of record, Applicant believes the pending claims of the above-captioned application are in allowable form and patentable over the prior art of record. Applicant respectfully requests reconsideration of the pending claims 1-83 and a prompt Notice of Allowance thereon.

Applicant believes that no extension of time is necessary to make this Response timely. Should Applicant be in error, Applicant respectfully requests that the Office grant such time extension pursuant to 37 C.F.R. § 1.136(a) as necessary to make this Response timely, and hereby authorizes the Office to charge any necessary fee or surcharge with respect to said time extension to the deposit account of the undersigned firm of attorneys, Deposit Account 50-0289.

Please direct any questions or comments to Daniel P. Malley at (607) 256-7307.

Respectfully submitted,

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